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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/907,635	08/08/1997	MIYUKI ENOKIDA	35.C10457CON	8513

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FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 101123801

EXAMINER	
HONG, STEPHEN S	

ART UNIT	PAPER NUMBER
2178	

DATE MAILED: 03/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)
08/907,635	Enokida et al.
Examiner	**Art Unit**
Stephen Hong	2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *three* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *Dec 27, 2002* .

2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *87-98* is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *87-98* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☒ All b) ☐ Some* c) ☐ None of:

1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____ .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
4) ☐ Interview Summary (PTO-413) Paper No(s). _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

Part III DETAILED ACTION

1. This action is responsive to communications: amendment filed on December 27, 2002 to the application filed 8/8/97, which is a FWC of the application Ser. No. 09/378,819, filed 1/27/95.

2. In the amendment claims 62-86 are canceled and claims 87-98 are added. Accordingly, claims 87-98 are pending in this case. Claims 87, 92, 93 and 98 are independent claims.

3. The rejections of claims 62-72, 76-82 and 86 under 35 U.S.C. 102(e) as being anticipated by Bonomi, and claims 73-75 and 83-85 under 35 U.S.C. § 103 as being unpatentable over Bonomi in view of Nguyen have been withdrawn as the claims have been canceled in the amendment.

Priority

4. Receipt is acknowledged of papers submitted under 35 U.S.C. § 119, which papers have been placed of record in the file.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 87-98 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The explanation of the rejection is provided below along with the 35 USC 112, second paragraph rejection.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 97-98 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per independent claim 87 (and similarly in independent claims 92, 93 and 98), the step "b" recites the limitation of first decoding step of decoding the moving image data which was encoded using intra-picture coding and inter-picture coding. The step "c" then recites "performing the inter-picture coding to the moving image data decoded in said first decoding step." This step "c" is rejected under 35 USC 112, second paragraph, since the step is vague and unclear as to whether or not all of the moving data (i.e., both the previously intra-picture and inter-picture coded) are now "inter-picture" coded. Furthermore, the step "c" is also rejected under 35 USC 112, first paragraph, since the specification fails to teach "inter-picture" coding all the images that have been decoded from the moving image which was encoded using intra-picture coding and inter-picture coding.

The step "d" recites "a second decoding step of reading the moving image data encoded in said first encoding step ...and decoding the read data." This step is rejected under 35 USC 112, second paragraph, since it is unclear what is meant by "decoding the read data." Note that the step "c" requires all data to now be encoded in the "inter-picture" coding. Therefore, it is unclear as to whether the "decoding" includes encoding into the "intra-picture" coded frames, or if not, into what form the "inter-picture" coded images are decoded. Furthermore, this step is rejected under 35 USC 112, first paragraph, since the specification does not disclose decoding the moving image data where all of the moving image data are encoded in the "inter-picture" encoding.

The step "e" recites "an editing step of performing an editing process to the moving image data decoded in said second decoded step." This step is rejected under 35 USC 112, second paragraph, since it is unclear what is being edited: "moving image" or "single image" from the moving image data. Furthermore, the step "e" is rejected under 35 USC 112, first paragraph, since the specification does not teach editing "inter-picture" decoded images. The specification only disclose editing decoded images that are in the "intra-picture" format.

The step "f" calls for "performing the inter-picture coding to the moving image data subjected to the edited process in said editing step..." This step is rejected under 35 USC 112, second paragraph, since the claimed language is vague as to whether all "edited" images are now encoded in the "inter-picture" coding. Furthermore, the step is rejected under 35 USC 112, first paragraph, since the specification dose not appear to teach that all edited images are afterward encoded into the "inter-picture" encoding.

The dependent claims are similarly rejected for fully incorporating all the limitations of their independent claims.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

10. Claims 87-89, 92-95 and 98 are rejected under 35 U.S.C. 102(e) as being anticipated by Bonomi, U.S. Pat. No. 5,577,191, 11/96 (filed 2/94).

As per independent claims 87, 92 and 98, Bonomi discloses the following claimed elements of a moving image editing apparatus:

- input means and decoding means for decoding encoded moving image data encoded by an encoding method that includes encoding using interframe correlation to an intraframe encoded moving image (col.2, line 54, "The video compression circuit ...compress the video data ...using both interframe and intraframe algorithm ...[and the] video decompression circuit decompresses intraframe-only compressed video data to allow editing");

- encoding means for intraframe coding the decoded moving image data and storing the intraframe encoded image data (col.4, line 25, "...in FIG.2, intraframe-only compressed video data is retrieved from storage" shows that the data have been stored.);

- editing means for decoding the image data which was stored in said storing means and intraframe encoded, and for performing an arbitrary editing on the encoded image data (col.2, line 57, "intraframe-only compressed video data ...allow video editing to occur in the host processor."); and

- second encoding means for encoding the edited image data by an encoded method that includes encoding in which the interframe correlation is considered (col.2, line 59, "When the video editing is complete, the video ....the video compression circuit to compress the video data using both intraframe and interframe algorithm.").

Bonomi further discloses **displaying the decoded image data** (col.3, line 52, "...decompressed the video data to display the video images on display").

As per dependent claims 88, Bonomi teaches encoding the images in MPEG, which contains the predetermined number of intra-coded pictures (see col.1, lines 25+, "the standard is the MPEG...") and JPEG (col.1, lines 40-45).

As per dependent claims 89, Bonomi teaches designating a picture for editing (col.3, lines 1-10).

Claims 93-95 recite substantially similar limitations as claims 87-89, respectively, and are similarly rejected under the same rationale.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
>
> Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

12. Claims 90-91 and 96-97 are rejected under 35 U.S.C. § 103 as being unpatentable over Bonomi in view of Nguyen, U.S. Pat. No. 5,404,437, 4/95 (filed 11/92).

As per dependent claims 90-91, Bonomi teaches the editing features of insertion and deletion of number of pictures. However, Nguyen discloses **animation images displayed in multi-screen displays that are obtained by reducing the frame images** (FIG.9 and col.9, lines 15-30). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined the teachings of Nguyen and Bonomi, since Nguyen taught the specific features of editing animation frames, and Bonomi explicitly suggested performing animation frame editions (col.1, line 52, "editing activities include special effects ..."). Nevertheless, Bonomi teaches the editing activities including "mixing, fades and wipes" (col.1, line 52), which require manipulating the number of pictures. Therefore, the features would have been obvious to a person of ordinary skill in the art at the time the invention was made in view of Bonomi's suggestions.

Claims 96-97 recite substantially similar limitations as claims 90-91, respectively, and are similarly rejected under the same rationale.

Response to Amendment

13. Applicant's arguments with respect to claims 87-98 have been considered but are moot in view of the new ground(s) of rejection.

As explained in the rejection of claims 87-98 under 35 USC 112, first and second paragraph, above, the claims as a whole fails to clearly define the invention. Therefore, as reasonably interpreted by the examiner, Bonomi clearly teaches and/or suggests the invention.

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steve Hong whose telephone number is (703) 308-5465. The examiner can normally be reached on Monday-Friday from 8:00 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached on (703) 308-5186.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Any response to this action should be mailed to:
Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 308-9051, (for formal communications; please mark "EXPEDITED PROCEDURE")

Or:

(703) 305-9724 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

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Stephen Hong

Primary Examiner

March 8, 2003